

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEOFFREY W. BLANEY and RICHARD R. TANGUM

Appeal No. 1999-1081
Application No. 08/458,983

ON BRIEF

Before ABRAMS, McQUADE, and GONZALES, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-9, 11- 18 and 66-71, which are all of the claims pending in the application.¹

We REVERSE.

¹On page 2 of the Answer, the examiner indicated that claim 16 would be allowable if rewritten in independent form, which means that this claim is not before us on appeal.

BACKGROUND

The appellants' invention relates to a building block. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dunker	4,624,089	Nov. 25, 1986
Marks	4,974,381	Dec. 4, 1990

Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1-9, 11-14 and 66-71 stand rejected under 35 U.S.C. § 102(b) as being anticipated by either of Marks or Dunker.

Claims 15 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over either of Marks or Dunker.

Claim 71 also stands rejected under 35 U.S.C. § 103 as being unpatentable over Marks.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper

No. 13) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No.12) and Reply Brief (Paper No. 14) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, the applied prior art references, the respective positions articulated by the appellants and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

Dependent claim 17 recites the spline as being "adapted to be connected to the at least one groove." It is the examiner's opinion that this renders the claim indefinite because it is not clear whether the spline is actually connected to the building block (Answer, page 4).

The purpose of the second paragraph of 35 U.S.C. § 112 is to insure that the public is apprised of exactly what a patent covers, so that those who would approach the area circumscribed by its claims may readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). In the present case, independent claim 1 is directed to a building block comprising a core, a cross strut through

the core, and a conduit attached to the cross strut. Claim 16 (which depends from claim 1) adds a groove within the core of the building block and claim 17 (which depends from claim 16) further requires that there be a spline having a portion of such structure as to render it adapted to be connected to the groove. From our perspective, while this might be considered to be a very broad recitation of the construction of the inventive building block, it is not indefinite merely because it does not positively connect the spline to the groove.

The rejection of claim 17 under the second paragraph of 35 U.S.C. § 112 is not sustained.

The Rejection Under 35 U.S.C. § 102(b)

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The examiner is of the view that all of the elements of the claimed invention are disclosed in either Marks or Dunker. The appellants assert in rebuttal that Marks and Dunker each are directed to a building panel of reinforced concrete, which is different from the building block which is the subject of independent claim 1, and therefore the references do not anticipate the subject matter recited in the claims. In support of this position, the

appellants have provided evidence in the form of excerpts from publications in the construction field. Nevertheless, the examiner maintains his position that “the terms to panel and block are merely nomenclature and do not, by themselves, serve to establish any patentable distinction. Size of the block or panel notwithstanding,” without making any comment at all regarding the appellants’ evidence or offering evidence in rebuttal (Answer, page 6).

We are persuaded by the evidence presented by the appellants that, in the field of building construction, “panel” and “block” are not merely alternative designations for the same structural element, but denote different elements. Of particular interest in this regard are pages 131 and 180 of Exhibit 2, in which the distinctions between “blocks” and “panels” clearly are established. It is our conclusion, therefore, that the claimed invention is not anticipated by either of the applied references.

The rejection of independent claim 1 and dependent claims 2-9, 11-14 and 66-71 is not sustained.

The Rejections Under 35 U.S.C. § 103

Dependent claims 15 and 18 stand rejected as being unpatentable over either Marks or Dunker, and dependent claim 71 over Marks. Even considering these references in the context of Section 103,² the deficiency in each reference that was pointed

²The test for obviousness is what the teachings of the prior art would have
(continued...)

out above with regard to the Section 102(b) rejection is not overcome, inasmuch as the record provides no reasons why one of ordinary skill in the art would have been motivated to apply the teachings of the references regarding building panel elements to building blocks, other than the hindsight afforded one who first viewed the appellants' disclosure.

The rejections of claims 15, 18 and 71 under Section 103 are not sustained.

²(...continued)
suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

SUMMARY

None of the rejections are sustained.

The decision of the examiner is REVERSED.

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JOHN F. GONZALES
Administrative Patent Judge

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